

Remarks

The Office Action dated September 28, 2009 lists the following new grounds of rejection: claims 1-8 and 12-16 stand rejected under 35 U.S.C. § 103(a) over Kerth (U.S. Patent No. 5,268,651) in view of Praria (U.S. Patent No. 4,505,032). Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant respectfully traverses the § 103(a) rejection because the cited combination of references lacks correspondence. For example, neither of the asserted references teaches the claimed invention “as a whole” (§ 103(a)) including, *e.g.*, claimed aspects directed to electrical connections between respective sub-bodies being exclusively via the taps connected to the respective resistor sub-bodies. Because neither reference teaches these aspects, no reasonable combination of these references can provide correspondence. As such, the § 103 rejection fails.

More specifically, the ‘651 reference teaches that the rows of resistive material are connected at alternative ends by bridging bar connections. The Office Action admits, on page 2, that in the ‘651 reference the rows of resistive material are not electrically connected to each other exclusively by taps, as are the resistor sub-bodies of the claimed invention. The proposed combination with the ‘032 reference does nothing to overcome this, because although electrical connectivity by taps may result, it is not the exclusive means of electrical connection, because the bridging bar connections still remain. Therefore, no reasonable interpretation of the asserted prior art, taken alone or in combination, can provide correspondence. Accordingly, the § 103(a) rejection of all claims fail and Applicant requests that it be withdrawn.

Moreover, the ‘651 reference teaches away from the proposed combination. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a §103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main (‘651) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007) (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.”). In this instance, Applicant submits that the

'651 reference teaches away from the electrical connections between the rows of resistive material being exclusively via taps because the '651 reference requires the bridging connections at alternative ends of the rows to achieve its stated purpose of reducing the contact drift problem. *See, e.g.*, Col. 2: 46-51 and 61-68. Therefore, one of skill in the art would not replace the bridging connections of the '651 reference with the taps of the '032 reference as proposed by the Office Action.

Further, the Office Action fails to establish a *prima facie* case of obviousness, in part, because the rejection does not meet the test for obviousness, which is set forth in the M.P.E.P. and by the U.S. Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (U.S. 2007). The Office Action fails to provide a valid reason for the proposed combination. In particular, the rejection relies upon the mistaken premise that a rejection can be shown simply by presenting a combination of "old elements." *KSR*, however, states that

(A) patent composed of several elements is *not* proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.
--*KSR* at 419 (*emphasis added*).

Thus, it is not sufficient to identify elements and then conclude that a combination is therefore obvious. Most inventions are, in some sense, implemented as combinations of known elements. The Office Action has provided no suggestion to combine except from using Applicant's invention as a template through a hindsight reconstruction of Applicant's claims. The U.S.P.T.O. Board has found this hindsight reconstruction to be invalid. *See Ex Parte Crawford et al*, Appeal 20062429, Decided May 30, 2007. As such, the rejection does not present a *prima facie* case of obviousness.

In view of the above, the rejection of claims 1-8 and 12-16 is improper and Applicant requests that it be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062 (or the undersigned).

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